

10/712,286

Attorney Docket No. 14649

REMARKS**I. Claim Status.**

Claims 1-14 are pending in the Application. This Response amends Claims 1, 5, 9 and 12.

II. Claim Amendments.

The amendments to Claims 1, 5, 9 and 12 do not add new matter or present new issues requiring further consideration or search. Further, the amendments place the case in condition for allowance or in better condition for appeal. Entry of the amendments is respectfully requested.

A. Amendments to Claims 1 and 5.

Claims 1 and 5 have been amended to add the limitation that "a portion of the pencil case being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the book rack, wherein a portion of the pencil case has a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and is sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the pencil case."

B. Amendments to Claims 9 and 12.

Claims 9 and 12 have been amended to add the limitation that the pencil case has "a pair of opposed side walls, a front wall and a rear wall, and a portion being sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the pencil case, and a portion of the pencil case being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the book rack".

The language newly added to Claims 1, 5, 9 and 12 is described on page 4, line 18 through page 5, line 1 of the Specification. Accordingly, these amendments do not add new matter.

In addition, the amendments to Claims 1, 5, 9 do not broaden the claims and thus do not present new issues requiring further consideration or search, and as described below, the amended claims are in condition for allowance or in better condition for appeal.

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Accordingly, Applicant respectfully requests entry of these amendments.

III. Applicant's Invention.

Applicants' invention is directed to a porous book rack which has a "pencil case" attached to the bookrack. The book rack with attached pencil case allows students to house books and notebooks in the bookrack portion and is suitable for retaining smaller items, such as pencils and pens, and intermediately sized items such as rulers and protractors within the walls of the pencil case so access to the book rack is not restricted.

Applicants' invention is a significant advantage to school districts because the combination of a pencil case and a porous book rack makes it difficult for a student to hide inappropriate objects (e.g., weapons, drugs, and other contraband) within the student's desk. Unfortunately, in modern times, there is a need for such an invention to increase the safety in our schools, and Applicants' invention satisfies this need.

IV. The Rejection Under 35 U.S.C. § 103.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Barecki (U.S. No. 3,758,182) in view of Alexander (U.S. No. 2,185,907) for the reasons stated in numbered paragraph 2 of the Office Action.

Applicants respectfully traverse this rejection on the basis that the Office has not established a *prima facie* case of obviousness. Applicants respectfully request withdrawal of the rejection and allowance of Claims 1-14 based on the following remarks.

A. Neither Barecki Nor Alexander Alone Or In Combination Describe Applicant's Invention.

As stated by the Office, "Barecki ('182) does not disclose expressly a pencil case attached with a pencil case attachment plate to the bookrack." (Office Action page 2, par. 2) In fact, Barecki does not disclose a pencil case or any other accessory attached to the tray, either by an attachment plate, or any other means. The Office looks to Alexander to remedy the deficiencies of Alexander. However, Alexander does not describe (i) a pencil case having a bottom wall, a pair of opposed side walls, a front wall and a rear wall, a portion of which sized to retain one or

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more of a ruler or a protractor in a linear manner within the walls of the pencil case, or (ii) a pencil case attached to the book rack, a portion of the pencil case being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the book rack.

1. The References Do Not Describe A Pencil Case Having Opposing Walls And Being Sized To Retain A Ruler Or A Protractor In A Linear Manner.

Each of the independent claims is limited to “a pencil case having a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and a portion being sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the pencil case”, in varying language. As admitted by the Office, Barecki does not expressly disclose a pencil case.

Alexander also does not teach or describe this limitation and does not remedy the deficiencies of Barecki. The tray disclosed in Alexander has a cup holder described as “a circular recess of a depth sufficient to receive and hold a tumbler or glass or other circular article” and an ash tray described as “formed by means of a depression . . . communicating with a curved portion forming a cigarette or cigar holder.” (Alexander, col. 2, lines 35-47). Neither of the holders described in Alexander has “opposed side walls, a front wall and a rear wall” as claimed by Applicant, both holders being round, or is “sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the pencil case”, both holders being too small to retain a ruler or a protractor in a linear manner.

Accordingly, the Office has not established a prima facie case of obviousness. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of all claims on this basis.

2. The References Do Not Describe A Pencil Case, A Portion Being Lower Than The Book Rack.

Each of the independent claims is limited to “a portion of the pencil case being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the book rack”, in varying language. As admitted by the Office, Barecki does not expressly disclose a pencil case.

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Alexander also does not teach or describe this limitation and does not remedy the deficiencies of Barecki. The Office asserts that the tray disclosed in Alexander has "a lower compartment (22) and an upper compartment (24). The lower compartment (22) is below the plane of the table surface (10) and sticks out in front of the table (13) as seen in Fig. 4 and 7." (Office Action, page 2, par. 2). This disclosure does not meet the limitations of Applicant's claims.

Applicant's claim a portion of a pencil case being "disposed in a generally horizontal plane at an elevation *lower than the bottom wall* of the book rack" (emphases added). As clearly shown in Alexander, Fig. 4, the circular recess (22) is flush with the bottom of the table (10) and the bead rail (13). The tray disclosed in Alexander, the bottom of which is flush with the table, does not teach or describe Applicant's claimed book rack and pencil case, a portion of which is "at an elevation lower than the bottom wall of the book rack".

Accordingly, the Office has not established a *prima facie* case of obviousness. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of all claims on this basis.

B. There Is No Suggestion Or Motivation To Combine Barecki With Alexander.

Applicants respectfully submit that one of ordinary skill in the art would not be motivated to modify or combine the rack disclosed in Barecki with the tray disclosed in Alexander because the proposed combination would change the principle of operation of Alexander and would not result in Applicants claimed invention. Accordingly, the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01.

Barecki discloses a desk with a rack. The Office admits that Barecki "does not disclose expressly a pencil case attached with a pencil case attachment plate to the bookrack." Office Action, page 2, par. 2). Alexander discloses a tray attached to a table. Thus, the combination of Barecki and Alexander results in a desk with a rack (as disclosed by Barecki) with a tray attached to a table (or desk) and not a pencil case (i.e., a tray) attached to a book rack as claimed by Applicant.

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As noted by the Office, the tray of Alexander is curved and designed to fit on the corner of a table (Office Action, page 4). In addition, the tray assumes "an even horizontal position when fastened in place upon a table" (Alexander, col. 2, lines 5-6). Although, as also noted by the Office, the mounting apparatus of the tray disclosed in Alexander is straight and *could* be mounted along a straight edge, this would result in a curved tray sticking out from the straight edge of a table, a fairly absurd configuration. The curved tray taught by Alexander is unsuitable as a "pencil case", a portion of which is "sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the pencil case". There is no motivation to combine Barecki with Alexander as modifying the tray disclosed in Alexander which is (i) curved in shape, (ii) extends around the corner of a table, and (iii) attached to a table top, would require a substantial redesign of the tray (none of which is taught or suggested) and changes the basic principle under which the tray operates, i.e., being attached to the corner of a table top, as opposed to being attached to the bottom of a rack.

Accordingly, there is no teaching or suggestion in either Barecki or Alexander of the proposed combination and the teachings of Barecki and Alexander are not sufficient to render Applicant's claimed book rack and pencil tray *prima facie* obvious. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of all claims on this basis.

CONCLUSION

Applicant believes that the claims are in condition for allowance and such action is earnestly requested. If any additional information should be required in considering this Response, or if there are any issues that can be resolved by telephone with the Applicants' representative, the Examiner is encouraged to contact the undersigned directly.

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No fee is believed due by this Response. However, if any fees are due, the Commissioner is authorized to charge any such fees to deposit account No. 19-2090.

Respectfully Submitted,
SHELDON & MAK PC

Date: February 6, 2006

By: 

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